

REMARKS

Claims 1-4 and 19 are now pending in the instant application. In the most recent Office Action, claims 15-18 are rejected under 35 U.S.C. § 101 for statutory double patenting as claiming the same invention as claims 17-20 of prior U.S. Patent No. 6,711,808 to Sollanek, et al. (hereinafter, "Sollanek"). Claims 1-11 are rejected on the ground of non-statutory obviousness type double patenting as being unpatentable over claims 1-11 and 13-15 of Sollanek.

As to claims 15-18, by the above amendment, these claims are cancelled, thereby obviating the rejection. Turning to claims 1-14 and 19, Applicant respectfully traverses the rejections, for at least the following reasons.

A double patenting rejection of the obviousness-type is "analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. 103". *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967). Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). In order to establish a *prima facie* case of obviousness, there must be some suggestion or motivation to modify the references. *See, In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). The absence of such a suggestion to combine is dispositive in an obviousness determination. *See, Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579 , 42 USPQ2d 1378, 1383 (Fed. Cir. 1997). "The showing of a motivation to combine must be clear and particular, and it must be supported by actual evidence." *Teleflex, Inc. v. Ficosa North American Corp.*, 299 F.3d 1313, 63 USPQ2d 1374 (Fed.

Cir. 2002) (Citing *In re Dembicczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)).

In this case, the Office Action fails to even suggest why one of ordinary skill would be motivated to modify the subject matter of the Sollanek claims to arrive at the invention of the pending claims. The Office Action avers that the claims of Sollanek 'anticipate' the claims rejected on these grounds. What the Office Action describes as 'anticipation' is in fact domination, i.e., the claims of the earlier Sollanek patent are encompassed by the instant claims. The Office Action correctly notes that the scope of the claims are in fact different.

Domination and obviousness are separate considerations. Domination exists where one claim defines in broad terms what would read on a narrower claim of another patent. *See, In re Kaplan*, 789 F.2d 1574, 229 USPQ 678 (Fed. Cir. 1986). The courts have held that the mere domination of the scope of one patent claim by the claims of another does not, *per se*, give rise to double patenting. *Id.*

Furthermore, the Office Action position that extension of term necessitates a terminal disclaimer is inapposite because the present application derives from the application granted as Sollanek, and both have the same effective filing date. A patent granted on the present application and Sollanek, but for patent term extension due to USPTO delay, would expire on the same day. See, 35 U.S.C. § 154. Therefore, Applicant respectfully submits that the rejection is poorly taken, and should be withdrawn.

However, in order to advance prosecution, Applicant submits herewith a statutory terminal disclaimer signed by an attorney of record. Applicant does not acquiesce in the

merits of the double patenting rejection. Filing a terminal disclaimer in response to a PTO obviousness-type double patenting rejection of a second patent application in view of a first patent creates no "presumption or estoppel on the merits of the rejection." *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991). See also, *Golight Inc. v. Wal-Mart Stores Inc.*, 355 F3d 1327, 69 USPQ2d 1481,1489 (Fed. Cir. 2004) ("No inference of concession or estoppel drawn from terminal disclaimer, where patentee argued the patentability of the claims without the terminal disclaimer.")

In light of the foregoing, Applicant respectfully submits that the Applicant is in condition for allowance, and kindly solicits and early and favorable Notice of Allowability on all claims. If the Examiner has any reservations in allowing the claims, and believes that a telephone interview would advance prosecution, he is kindly requested to telephone the undersigned at his earliest convenience.

Respectfully Submitted,



David J. Torrente
Registration No. 49,099

Scully, Scott, Murphy & Presser, P.C.
400 Garden City Plaza, Suite 300
Garden City, New York 11530
(516) 742-4343

DJT:gc